

REMARKS

In the Office Action, the Examiner objected to the drawings as allegedly failing to show every feature specified in the claims. Applicants respectfully disagree for the following reasons.

First, the Examiner alleges that the drawings fail to show physically attaching a device to another device. Applicants respectfully disagree and note that Figure 3 explicitly shows the step of "Provider connects to recipient" at the step indicated by the numeral 30. Furthermore, the specification states that the "method begins with the card being physically inserted into the expansion slot of the PDA (step 30)." See Patent Application, page 6, lines 25-26.

Second, the Examiner alleges that the drawings fail to show selecting the first communication protocol from the plurality of communication protocols. Applicants respectfully disagree and submit that the selection is depicted as the yes/no branch leading to the two possible steps of "send a signal indicating new protocol" (indicated by 32a) and "send a signal indicating an existing protocol" (indicated by 32b). The selection process is also described in the corresponding section of the specification. See Patent Application, page 6, lines 26-30.

For at least the aforementioned reasons, Applicants respectfully submit that the drawings show all of the features specified in the pending claims. Applicants respectfully request that the Examiner's objections to the drawings be withdrawn.

Claims 1-7 and 9-10 are pending in the present application. In the Office Action, claims 1-7 and 9-10 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Lambert, et al. (U.S. Patent No. 6,434,660) in view of Ishii (U.S. Patent No. 6,594,505). Applicants respectfully traverse the Examiner's rejections.

A finding of obviousness under 35 U.S.C. § 103 requires a determination of the scope and content of the prior art, the level of ordinary skill in the art, the differences between the

claimed subject matter and the prior art, and whether the differences are such that the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Graham v. John Deere Co.*, 148 USPQ 459 (U.S. S.Ct. 1966). To determine whether the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made, one should determine whether the prior art reference (or references when combined) teach or suggest all the claim limitations. Furthermore, it is necessary for the Examiner to identify the reason why a person of ordinary skill in the art would have combined the prior art references in the manner set forth in the claims. Teaching away by the prior art may constitute *prima facie* evidence that the claimed invention is not obvious.

Independent claims 1, 5, and 7 set forth, among other things, physically attaching a first electronic device having a first communication protocol to a second device having a plurality of communication protocols. For example, an expansion card may be physically inserted into an expansion slot of a personal data assistant. See Patent Application, page 6, ll. 20-25. The pending claims further set forth transferring the second communication protocol from the second device to the first device and installing the second communication protocol on the first device so that the second communication protocol can be used for further communication between the first device and the second device.

Lambert is concerned with the fact that some device manufacturers define a specific command set that can be used by flash memory cards that are inserted into a device such as a personal digital assistant (PDA). The card manufacturer can design the flash memory cards to use this command set to achieve higher speed and/or other capabilities. However, using this command set locks the card manufacturer into a particular device manufacturer's specification.

Lambert therefore describes a flash memory card that includes a translator inside a flash memory card controller. The translator translates commands from a host system conforming to a manufacturer protocol to commands that are recognized by the flash chips of another manufacturer. See Lambert, col. 1, line 57 – col. 2, line 23.

However, as admitted by the Examiner, Lambert does not describe or suggest establishing communication between the first and second devices using the first communication protocol. The Examiner also acknowledges that Lambert does not describe or suggest transferring a second communication protocol from the second device to the first device, installing the second communication protocol on the first device, and switching to the second communication protocol for further communication. The Examiner therefore alleges that Ishii describes these features and alleges that it would have been obvious for a person of ordinary skill in the art to have combined Lambert and Ishii to arrive at the subject matter set forth in the pending claims. Applicants respectfully disagree for at least the following reasons.

Ishii describes a mobile radio telephone 3 that may download communication protocol software from a base station 1 over a wireless communication link or air interface. See Ishii, col. 5, ll. 1-6 and Figure 1. However, the mobile radio telephone 3 is not physically attached to the base station 1. To the contrary, Ishii teaches that mobile telephones located in a communication area associated with either a first or second base station may download first or second mobile radio telephone communication protocol software from the first or second base stations depending on which base station is serving the communication area. See Ishii, col. 4, ll. 27-51. When taken in context, Applicants submit that the description in Ishii is describing downloading the mobile radio telephone communication protocol software over an air interface.

The Examiner alleges that it would have been obvious to combine the teachings of Lambert and Ishii to transfer a protocol if emulation failed. Applicants respectfully disagree and submit that the Examiner has not provided any support for this conclusory statement. In particular, Applicants respectfully submit that the Examiner has not provided any reason that a person of ordinary skill in the art would have been motivated to utilize a technique for downloading communication protocol software over an air interface (as described by Ishii) between a flash memory card to a PDA (as described by Lambert). Applicants respectfully submit that combining and modifying the prior art in the manner suggested by the Examiner would require installing wireless communication hardware, software, and/or firmware in both the PDA and the flash memory card. Applicants respectfully submit that while some PDAs may include wireless communication capabilities, persons of ordinary skill in the art should appreciate that installing wireless communication capabilities in a flash memory card is impractical and would defeat the primary purpose of the flash memory card, *i.e.*, to provide a relatively large and easily accessed memory element that has a small (and standardized) form factor that allows the card to be inserted in devices such as PDAs.

Furthermore, Applicants respectfully submit that both of the cited references to teach away from the Examiner's proposed combination and modification of the prior art.

First, as discussed herein, Lambert describes incorporating a translation element into a flash memory card controller so that various manufacture-specified commands can be translated into commands that are understood by different types of memory elements in the flash memory card. Accordingly, Applicants respectfully submit that Lambert teaches that the translation element in the flash memory card allows the flash memory card to be used in devices without any modification to the devices or the protocols used by these devices. Applicants respectfully

submit that this teaches away from transferring a second communication protocol from the second device to the first device, installing the second communication protocol on the first device, and switching to the second communication protocol for further communication, as set forth in the pending claims.

Second, Applicants also respectfully submit that Ishii teaches that communication between mobile phones and base stations takes place over an air interface. For example, Ishii teaches that mobile telephones located in a communication area associated with either a first or second base station may download first or second mobile radio telephone communication protocol software from the first or second base stations depending on which base station is serving the communication area. See Ishii, col. 4, ll. 27-51. Consequently, Applicants respectfully submit that Ishii teaches away from physically connecting a mobile telephone to a base station for any purpose and, in particular, for the purpose of downloading communication protocol software.

For at least the aforementioned reasons, Applicants respectfully submit that the Examiner has failed to make a *prima facie* case that claims 1, 5, and 7 would have been obvious over the prior art of record. Claims 2-4 depend from claim 1. Claim 6 depends from claim 5. Claims 9-10 depend from claim 7. Applicants therefore submit that these claims would not have been obvious over the prior art of record for at least the reasons discussed above with regard to claims 1, 5, and 7. Applicants request that the Examiner's rejections of claims 1-7 and 9-10 under 35 U.S.C. § 103(a) be withdrawn.

For at least the aforementioned reasons, it is respectfully submitted that all pending claims are in condition for allowance. The Examiner is invited to contact Mark W. Sincell at

(713) 934-4052 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

WILLIAMS, MORGAN & AMERSON
CUSTOMER NO. 23720

/Mark W. Sincell/

Mark W. Sincell

Reg. No. 52,226

10333 Richmond, Suite 1100

Houston, Texas 77042

(713) 934-4052

(713) 934-7011 (facsimile)

AGENT FOR APPLICANTS

Date: November 13, 2008